REMARKS

Claims 1-28 and 31-38 are pending in the present application. Claims 29 & 30 are canceled, and claims 1, 15, 16, 18, 19, 33, 34, 36, 37 & 38 are amended. Reconsideration of the claims is respectfully requested.

I.   **35 U.S.C. § 102, Alleged Anticipation**

The Examiner has rejected claims 1-2 and 7-14 under 35 U.S.C. § 102(b) as being allegedly anticipated by Smith et al. (Transcoding Internet Content for Heterogeneous Client Devices). This rejection is respectfully traversed.

With regard to claim 1, the Office Action states:

Smith et al teach a transcoder processing system implemented method for converting documents based on semantic characteristics, comprising (figure 1, his Internet content Transcoding system, pages III-599 to III-602):
"Receiving a request for a document client" (his client device, page III-599, section 2, His Internet content transcoder, a policy engine gathers the capabilities of the client, the networks conditions and the Transcoding preference of the user and publisher)"
"Passing the request to an origin server" (the request from the client server is passed to the publisher (server));
"Performing a syntactical Transcoding on the request document wherein at least one semantic at least one semantic characteristic of the request document is converted" (figure 1, his Internet content transcoder, Section 2, page III-599, the system selects the outputting versions of the contents and uses a library of content analysis, filtering translation and manipulation routines to generate the content to be delivered to the client);
and
"Sending the requested document to the client" (the system is able to retrieve the Internet content, analyze and transcode it and deliver it to the client, III-599-III-600).

Office Action dated July 21, 2003, page 2.

Claim 1 reads as follows:

1. A transcoder processing system implemented method for converting documents based on semantic characteristics, comprising:
    receiving a request for a document from a client;
    passing the request to an origin server;
    receiving the requested document from the origin server;
    determining information regarding each semantic characteristic of a requested document <u>wherein the information regarding each semantic characteristic is contained within a semantic tag in the requested document</u>;

performing a syntactical transcoding on the requested document, wherein at least one semantic characteristic of the requested document is converted <u>based on the information regarding each semantic characteristic of the requested document</u>; and

sending the requested document with the at least one converted semantic characteristic to the client. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Smith et al does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, Smith does not teach a transcoding processing system wherein the information regarding each semantic characteristic is contained within a semantic tag in the requested document.

Smith broadly teaches an internet transcoder but is more specifically directed to an InfoPyramid transcoding scheme to manipulate internet data so as to properly display customized web content on a variety of client devices. Web content is gathered and formatted into the InfoPyramid. A policy engine gathers the capabilities of the client device, network conditions, and user preferences. The system then selects the best suited output version to display. Such formatting can include a change in modalities such as a video clip to an audio clip, or a change in fidelity such as lossy compression of a video.

The Office Action alleges that Smith teaches all of the features of independent claim 1. Applicants respectfully disagree. Specifically, Smith does not teach a transcoding processing system wherein the information regarding each semantic characteristic is contained within a semantic tag in the requested document. The Examiner alleges that Figure 1 and Section 2 on pages III-599 and III-600 teach this feature. The text as cited by the Examiner for allegedly teaching this feature reads as follows:

Figure 1 illustrates the proposed Internet content transcoding system. The system retrieves and analyzes the Internet content and ingests it into the InfoPyramid format. A policy engine gathers the capabilities of the client, the network conditions and the transcoding preferences of the user and publisher. This information is used to define the transcoding options for the client. The system then selects the output versions of the content and uses a library of content analysis, filtering, translation and manipulation routines to generate the content to be delivered to the client device.

The Internet content transcoding system may be deployed at the server, proxy or client. Deployed at the proxy, the system is able to retrieve the internet content, analyze and transcode it, and deliver the results to the client, on-the-fly. Deployed at the server, the system can be used in the content publication process. The system can pre-materialize the alternate versions of the Internet content and store them on the server. In this case, the system merely selects the versions of the content to deliver to the client. In some cases, the transcoding system can be deployed at the client to customize the content display, such as according to the user preferences, as long as the client has sufficient capabilities.

Nowhere in this text or anywhere else in the this reference does Smith teach or suggest the use of semantic tags. While Smith teaches a system that is capable of converting content between modalities as well as changing the fidelity, Smith clearly does not teach the use of semantic tags. The present invention's specification, on the other hand, notes that semantic tags may be used to determine document attributes:

The semantic-crawler might also tag each word dealing with certain semantic characteristics, such as time, date, monetary units, or units of measure. In so doing, the transcoding proxy need only search for the tagged terms and words, and convert the terms according to the user preferences.

Thus, as Smith fails to teach the claimed feature of a "requested document wherein the information regarding each semantic characteristic is contained within a semantic tag in the requested document," Smith fails to anticipate the present invention as recited in claim 1.

Moreover, Smith does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement Smith to include the use of semantic tags in semantic character recognition, one of ordinary skill in the art would not be led to modify Smith to reach the present invention when the reference is examined as a whole. Absent

some teaching, suggestion, or incentive to modify Smith et al. in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

In view of the above, Applicants submit that Smith et al does not teach each and every feature of independent claim 1 as required under 35 U.S.C. § 102(b). At least by virtue of their dependency on claim 1, Smith et al does not teach each and every feature of dependent claims 2-14. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-14 under 35 U.S.C. § 102(b).

Furthermore, with regard to claim 2, the Office Action alleges that Smith teaches the feature "receiving at least one semantic characteristic preference from the client, wherein the at least one semantic characteristic is automatically converted based on the at least one semantic characteristic preference," in Figure 1 and Section 2 of Smith. Applicants respectfully disagree and furthermore, direct the Examiner to the detailed discussion on both Figure 1 and Section 2 as noted above. Smith does not teach receiving at least one semantic characteristic preference from the client. Smith merely suggests semantic characteristics may be used in text summarization and language translation. However, there are multitudes of ways to accomplish text summarization and language translation of a document.

Simply suggesting the use of semantic characteristics does not imply that a client defines the preferences. For example, a proxy server may instead define the necessary language translation of a document based on the location of the server. Furthermore, Smith does not suggest that "his client preference" (as the Examiner refers to it) pertains to semantic characteristic preferences in any way. Smith simply states "Both the publisher and user may have preferences for how the content is transcoded." This is a very broad statement that does not deem the use of semantic characteristic preferences as inherent in Smith. Because Smith's teachings as to the use of semantic features is so vague, one can not extract that semantic characteristic preferences are set by the client because this feature is not taught anywhere in the reference.

Regarding claims 7 and 8, the Office Action alleges that Smith teaches that a semantic characteristic is in conformance with governmental regulations of the requested

documents. Applicants respectfully disagree. The Examiner alleges this is anticipated because the "transcoding proxies generates and selects versions of the content according to policies (governmental regulations)."

A policy engine is not related to governmental rules and regulations. Rather, it is a mechanism to determine and solve various network issues based on an established policy. A policy is a set of rules for the transcoder to follow when handling network traffic. A policy can be rule based, case based, probability based, etc. This is a known definition to one of ordinary skill in the art and thus, the Examiner has interpreted the meaning of a policy, in this context, incorrectly. Moreover, a review of section 4 in Smith will confirm the assertions made by Applicants regarding the definition of a policy and a policy engine. Applicants submit that Smith makes no mention of government regulations within section 4, or anywhere else in the reference for that matter. Therefore, Applicants respectfully submit that Smith does not teach or suggest the features of claims 7 and 8.

II.   35 U.S.C. § 103, Alleged Obviousness

The Examiner has rejected claims 3-6 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Smith et al (Transcoding Internet Content for Heterogeneous Client Devices). This rejection is respectfully traversed.

With regard to claims 3 and 4, the Office Action states:

> Smith et al teach the semantic characteristic preference specified by the user (his transcoding preference of the user) but does not explicitly teach semantic characteristic preference specified by a client is readability level of the requested document". However, Official Notice is taken that this feature is well known in the linguistic art. Therefore, one having ordinary skill in the art at the time the invention was made would have it obvious to recognized that the characteristic preference of the user could be the readability level of the requested document because it would allow facilitate the reading and the understanding of the document.

Applicants agree with the Office Action that Smith does not teach that a semantic characteristic preference specified by the client is readability level of the requested document. Rather than actually finding this feature in any secondary reference, however, the Examiner merely alleges that this feature is old and well known. Applicants

respectfully disagree and request that the Examiner cite a reference in support of the allegation that this feature is old and well known.

Applicants direct the Examiner to page 19, lines 18-25 of the specification as an exemplary embodiment for the purpose of clarification on the context of the term readability level:

> A fifth-grade student has a different level of language skill than an English Ph.D. However, they may both need to read an article on the same topic on the internet. A document on the selected topic could be presented at various readability levels, either by dynamic conversion to various readability levels or via multiple static versions, each with an associated readability level.

While the general concept of readability may be old and well known, Applicants respectfully assert that transcoding a document based on readability level is not. Furthermore, this is not the problem that Smith is concerned with and thus, Smith does not even suggest including readability level as a semantic characteristic preference. Therefore Applicants respectfully submit that Smith does not teach or suggest the features of claims 3 and 4.

With regard to claims 5 and 6, the Office Action states:

> Smith et al teach the semantic characteristic preference specified by the user (his transcoding preference of the user) but does not explicitly teach semantic characteristic preference specified by a client is locale. However, Official Notice is taken that this feature is well known in the linguistic art. Therefore, one having ordinary skill in the art at the time the invention was made would have it obvious to recognize that the characteristic preference of the user could be the locale because it would facilitate the understanding of the document in a locale which the user is familiarize with.

Applicants agree with the Office Action that Smith does not teach that a semantic characteristic preference specified by the client is client locale. Rather than actually finding this feature in any secondary reference, however, the Examiner merely alleges that this feature is old and well known. Applicants respectfully disagree and request that the Examiner cite a reference in support of the allegation that this feature is old and well known. While the general concept of locale characteristics may be old and well known, Applicants respectfully assert that transcoding a document based on locale is not. Furthermore, this is not the problem that Smith is concerned with and thus, Smith does not

even suggest including locale as a semantic characteristic preference. Therefore Applicants respectfully submit that Smith does not teach or suggest the features of claims 5 and 6.

Since the Examiner fails to cite any reference that teaches or suggests the specific features of claims 3-6, and merely makes an allegation without any supporting evidence, the Examiner has failed to establish a prima facie case of obviousness with regard to claims 3-6. Thus, unless the Examiner is able to cite a reference in support of the allegations made with regard to claims 3-6 then Applicants are entitled to a grant of patent on claims 3-6.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). Applicants respectfully submit that Smith does not teach or suggest all of the features cited in claims 3-6, the Examiner has failed to cite a reference that teaches or suggests these features, and thus, Applicants are entitled to grant of a patent on claims 3-6.

In view of the above, Applicants respectfully submit that Smith does not teach or suggest the features of claims 3-6. Furthermore, the Office Action has failed to set forth a prima facie case of obviousness because the rejection of claims 3-6 is based completely on unsubstantiated allegations made by the Examiner rather than any explicit teaching or suggestion in any prior art reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-6 under 35 U.S.C. § 103(a)

III.   **Rejection of Claims 15-38**

The Examiner has rejected claims 15-38 alleging that they are in the same scope and content as claims 1-14. This rejection is respectfully traversed.

The Examiner has failed to properly address claims 15-38. It is unclear under which category of rejections each of these claims fall, i.e. 35 U.S.C. § 102 or 35 U.S.C. § 103 since some of claims 1-14 are rejected under 35 U.S.C. § 102 and some are rejected under 35 U.S.C. § 103. Applicants respectfully request the Examiner to address each of these claims, clearly indicate which sections of 35 U.S.C. the claims are rejected under, and cite a specific area in the reference that teaches or suggests the features of claims 15-38.

Claim 15, which is representative of claim 33 with regard to similarly recited subject matter, reads as follows:

> 15. A transcoder processing system implemented method for converting documents based on semantic characteristics, comprising:
>   receiving at least one semantic characteristic preference from a client wherein the semantic characteristic preference is selected from the group including readability level, locale and compliance with government regulations;
>   syntactically transcoding a document; and
> converting at least one of the semantic characteristics of the document, wherein converting is based on the at least one semantic characteristic preference. (emphasis added)

For the same reasons as set forth above regarding readability level, locale and government regulations, Smith does not teach that a semantic characteristic preference is selected from the group including readability level, locale and compliance with government regulations. Particularly, claims 3 and 4 recite the feature of readability as a semantic characteristic. The Examiner has taken Official Notice that this feature is old and well known. Applicants respectfully disagree. While the general concept of readability may be old and well known, Applicants respectfully assert that transcoding a document based on readability level is not. Furthermore, this is not the problem that Smith is concerned with and thus, Smith does not even suggest including readability level as a semantic characteristic preference.

Similarly, claims 5 and 6 recite the feature of locale as a semantic characteristic. The Examiner has taken Official Notice that this feature is old and well known.

Applicants respectfully disagree. While the general concept of locale characteristics may be old and well known, Applicants respectfully assert that transcoding a document based on locale is not. Furthermore, this is not the problem that Smith is concerned with and thus, Smith does not even suggest including locale as a semantic characteristic preference.

In addition, claims 7 and 8 teach the feature of using compliance with government regulations as a semantic characteristic. The Examiner alleges this is anticipated because the "transcoding proxies generates and selects versions of the content according to policies (governmental regulations)." Applicants respectfully disagree. As set forth above, a policy engine is not related to governmental rules and regulations. Rather, it is a mechanism to determine and solve various network issues based on an established policy.

In view of the above, Applicants submit that Smith does not teach or suggest each and every feature of independent claims 15 and 33 as required under 35 U.S.C. § 103(a). At least by virtue of their dependency on claims 15 and 33, Smith does not teach each and every feature of dependent claims 16, 17, 34 and 35. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 15-17 and 33-35 under 35 U.S.C. § 103(a).

Additionally, Applicants submit that Smith does not suggest making the necessary modifications to reach the features of claims 15 and 33. Absent the Examiner pointing out some teaching or incentive to implement Smith to receive at least one semantic characteristic preference from a client wherein the semantic characteristic is selected from the group including readability level, locale and compliance with government regulations, one of ordinary skill in the art would not be led to modify Smith to reach the present invention when the reference is examined as a whole.

Claim 18, which is representative of claims 36 and 38 with regard to similarly recited subject matter, reads as follows:

18. A transcoder processing system implemented method for converting documents based on semantic characteristics, comprising:
   requesting a document from an origin server from a client;
   transmitting at least one semantic characteristic preference from a client, wherein the at least one semantic characteristic preference is one of readability level, locale and compliance with governmental regulations; and

receiving the document, wherein the document has been syntactically transcoded and converted using the at least one semantic characteristic preference. (emphasis added)

For the same reasons as set forth above, Smith does not teach at least one semantic characteristic preference is one of readability level, locale and compliance with governmental regulations. Specifically, the argument set forth with regard to claims 15 and 33 apply equally to claims 18, 36 and 38.

In view of the above, Applicants submit that Smith does not teach or suggest each and every feature of independent claims 18, 36 and 38 as required under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request withdrawal of the rejection of claims 18, 36 and 38 under 35 U.S.C. § 103(a).

Additionally, Applicants submit that Smith does not suggest making the necessary modifications to reach the features of claims 18, 36 and 38. Absent the Examiner pointing out some teaching or incentive to implement Smith to transmit at least one semantic characteristic preference from a client, wherein the at least one semantic characteristic preference is one of readability level, locale and compliance with governmental regulations, one of ordinary skill in the art would not be led to modify Smith to reach the present invention when the reference is examined as a whole.

Regarding claims 19 and 37, the Examiner has not specifically addressed these claims. However, claims 19 and 37 recite similar subject matter to claim 1. Therefore claims 19 and 37 are allowable due to similar reasoning as set forth above.
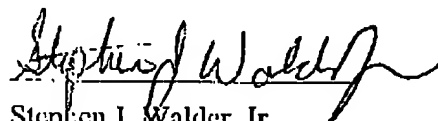
In view of the above, Applicants submit that Smith does not teach or suggest each and every feature of independent claims 19 and 37 as required under 35 U.S.C. § 103(a). At least by virtue of their dependency on claim 19, Smith does not teach each and every feature of dependent claims 20-28, 31 and 32. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 19-28, 31, 32 and 37 under 35 U.S.C. § 103(a).

III.   Conclusion

It is respectfully urged that the subject application is patentable over Smith and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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